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10/026,555	12/27/2001	Miyuki Sato	1075.1187	9596
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HAMILTON, MATTHEW L	
			ART UNIT 3609	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/026,555

Applicant(s)

SATO ET AL.

Examiner

Matthew L. Hamilton

Art Unit

3609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 1-9, 22-23, 25-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/27/01, 1/05/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 27 August 2001.
2. Claims 1-28 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statements filed on 27 December 2001 and 5 January 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Inventorship***

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Specification***

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.
6. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form

and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

7. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

9. Claim 22 is objected to because of the following informalities: Claim 22 the number 4 was inadvertently placed between the parentheses. Appropriate correction is required.

10. Claims 1-9, 22-23 and 25-28 are objected to because of the following informalities: Claims have the limitation "the *last-named individual customer*" it's not clear whether it refers to "*individual customer*". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 10, 13, 16 and 19 recite the limitation "*said cash dispenser*" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-6, 22, 25, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke US Patent 6,088,682.

**Claims 1, 22, 25 and 28:**

- *a change information input section for inputting change information about an amount of change that is to be returned to an individual customer by a service provider as the balance of a payment with one or more banknotes and/or large coins for each service at the service provider (see column 1, lines 20-31 and column 2, 33-38 and lines 39-46);*
- *(b) a change summing section for summing the individual amounts of change, which have been input by said change information input section, for each customer (see column 8, lines 1-5 and lines 9-11);*
- *(c) a judgment section for discriminating whether or not the total amount of change for an individual customer as the result of the summing by said change summing section reaches a predetermined amount (see column 3, lines 34-37 and column 6, lines 17-18);*
- *(d) a notifying section for, if the result of the discrimination by said judgment section is positive, notifying the last-named individual customer of such positive result of the discrimination (see column 3, lines 31-33);*
- *and (e) a transfer transaction section for performing a transfer transaction of at least part of said total amount of change to an account of said last-named individual customer (see column 2, lines 39-46 column 9, lines 62-67 column 10, lines 1-3).*

**Claim 2:**

- *comprising a cash dispenser for dispensing said at least part of said total amount of change, which has been transferred to the account of said last-named individual customer by said transfer transaction section, to said last-named individual customer (see column 3, lines 26-31 column 9, lines 26-30).*

**Claim 3:**

- *wherein said transfer transaction section performs said transfer transaction at the request of said last-named individual customer which request is made on said cash dispenser designated by the service provider (see column 10, lines 33-37 and lines 62-67 column 11, lines 1-3).*

**Claims 4, 5, and 6:**

- *comprising an incentive award granting section for granting an incentive award to said last-named individual customer if the result of the discrimination by said judgment section is positive (see column 12, lines 62-67 column 13, lines 1-4 and column 16, lines 40-44).*

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7-9, 10-21, 23-24 and 26-27 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke in view of Harms et al US Patent 6,070,147.

Art Unit: 3609

**Claims 7, 8, 9:**

Burke does not disclose the following limitation:

- *comprising an incentive award selection section for offering a plurality of optional incentive awards for selection by said last-named individual customer, said incentive award granting section being responsive to said last-named individual customer's selection with said incentive award selection section to grant the selected incentive award to said last-named individual customer.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because "Loyalty marketing criteria is stored in the database 50 shown in FIG. 4. The database 50 stores, in some form, the criteria that must be met in order to receive an award. The loyalty marketing criteria specifies, for each retail outlet, mall, or the like, the requirements for receiving various awards or marketing incentives. For example, as shown in FIG. 8(a), the criteria for ABC Grocery Store is structured as an account balance program. When a consumer's points reach 600 or higher, the consumer qualifies for the first award level. Each award level qualifies the consumer to choose an award from a class of awards. For example, the consumer may be able to choose an award from a class of awards that includes a \$25 gift certificate to be redeemed for store merchandise, a \$20 cash award, or a gift certificate for another store" (see at least Harms column 8, lines 8-22).

**Claims 10-21:**

Burke does not disclose the following limitation:

- *wherein said incentive award selection section is incorporated in said cash dispenser designated by the service provider.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because

Art Unit: 3609

*"Alternatively, the retailer at the point of sale might be notified by the central processing system so that the retailer could issue the reward to the consumer directly, in the form of merchandise, cash, a discount, or the like. Redeeming or granting such an award will debit the consumer's account. After redemption, the consumer is preferably made aware of his or her new balance"* (see at least Harms column 11, lines 29-35)

**Claim 23:**

Burke does not disclose the following limitation:

- *A cash dispenser for dispensing to a customer cash of an account of the customer, equipped with an incentive award granting section for granting an incentive award to an individual customer if the sum of individual amounts of change that are to be returned to the last-named individual customer by a service provider each as the balance of a payment with one or more banknotes and/or large coins for each service at the service provider reaches a predetermined amount.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because *"Alternatively, the retailer at the point of sale might be notified by the central processing system so that the retailer could issue the reward to the consumer directly, in the form of merchandise, cash, a discount, or the like. Redeeming or granting such an award will debit the consumer's account. After redemption, the consumer is preferably made aware of his or her new balance"* and *"Loyalty marketing criteria is stored in the database 50 shown in FIG. 4. The database 50 stores, in some form, the criteria that must be met in order to receive an award. The loyalty marketing criteria specifies, for each retail outlet, mall, or the like, the requirements for receiving various awards or marketing incentives. For example, as shown in FIG. 8(a), the criteria for ABC Grocery Store is structured as an account balance program. When a consumer's points reach 600 or higher, the consumer*



Art Unit: 3609

*qualifies for the first award level"* (see at least Harms column 11, lines 29-35 and column 8, lines 8-17)

**Claim 24:**

Burke does not disclose the following limitation:

- *an incentive award selection section for offering a plurality of optional incentive awards for selection by said individual customer, said incentive award granting section being responsive to said individual customer's selection with said incentive award selection section, to said individual customer.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because "*Loyalty marketing criteria is stored in the database 50 shown in FIG. 4. The database 50 stores, in some form, the criteria that must be met in order to receive an award. The loyalty marketing criteria specifies, for each retail outlet, mall, or the like, the requirements for receiving various awards or marketing incentives. For example, as shown in FIG. 8(a), the criteria for ABC Grocery Store is structured as an account balance program. When a consumer's points reach 600 or higher, the consumer qualifies for the first award level. Each award level qualifies the consumer to choose an award from a class of awards. For example, the consumer may be able to choose an award from a class of awards that includes a \$25 gift certificate to be redeemed for store merchandise, a \$20 cash award, or a gift certificate for another store*" (see at least Harms column 8, lines 8-22).

**Claim 26:**

Burke does not disclose the following limitation:

- *comprising the step of granting an incentive award to said last-named individual customer if the result of said discriminating step (c) is positive.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would

Art Unit: 3609

have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because *"Loyalty marketing criteria is stored in the database 50 shown in FIG. 4. The database 50 stores, in some form, the criteria that must be met in order to receive an award. The loyalty marketing criteria specifies, for each retail outlet, mall, or the like, the requirements for receiving various awards or marketing incentives. For example, as shown in FIG. 8(a), the criteria for ABC Grocery Store is structured as an account balance program. When a consumer's points reach 600 or higher, the consumer qualifies for the first award level. Each award level qualifies the consumer to choose an award from a class of awards. For example, the consumer may be able to choose an award from a class of awards that includes a \$25 gift certificate to be redeemed for store merchandise, a \$20 cash award, or a gift certificate for another store"* (see at least Harms column 8, lines 8-22).

**Claim 27:**

Burke does not disclose the following limitation:

- *comprising the step of offering a plurality of optional incentive awards for selection by said last-named individual customer so that said incentive award selected by said last-named individual customer in said incentive award offering step is granted to said last-named individual customer in said incentive award granting step.* Harms however, discloses a loyalty marketing plan that rewards customers when certain criteria are met in column 11, lines 22-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine funds distribution system connected to a point of sale transactions with the loyalty marketing criteria of Harms because *"Loyalty marketing criteria is stored in the database 50 shown in FIG. 4. The database 50 stores, in some form, the criteria that must be met in order to receive an award. The loyalty marketing criteria specifies, for each retail outlet, mall, or the like, the requirements for receiving various awards or marketing incentives. For example, as shown in FIG. 8(a), the criteria for ABC Grocery Store is structured as an account balance program. When a consumer's points*

Art Unit: 3609

*reach 600 or higher, the consumer qualifies for the first award level. Each award level qualifies the consumer to choose an award from a class of awards. For example, the consumer may be able to choose an award from a class of awards that includes a \$25 gift certificate to be redeemed for store merchandise, a \$20 cash award, or a gift certificate for another store" (see at least Harms column 8, lines 8-22).*

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Hamilton whose telephone number is (571) 270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m Est alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Reagan can be reached on (571) 272-6710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*\*Matthew Hamilton

Patent Examiner

July 2, 2007



JAMES REAGAN  
SUPERVISORY PATENT EXAMINER

